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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 11
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re I.T.C. Limited

Serial No. 75/615,020

Karla C. Shippey and Dana E. Stewart of Hilborne, Hawkin & Co.¹ for I.T.C. Limited.

Richard S. Donnell, Trademark Examining Attorney,² Law Office 106 (Mary Sparrow, Managing Attorney).

Before Seeherman, Bottorff and Rogers, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

I.T.C. Limited has appealed from the final refusal of the Trademark Examining Attorney to register WILLS SPORT and design, as shown below, for "culottes, jackets including leather jackets, jogging suits, pants, sweat pants, polo shirts, golf shirts, knit shirts, sports

¹ Another attorney with the firm prepared applicant's appeal brief.

² Mr. Donnell prepared the appeal brief; another Examining Attorney prepared the Office Actions during the examination of the application.

shirts, t-shirts, sweat shirts, evening gowns, shorts, tank tops, footwear including athletic shoes."³

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark WILLS & CO., with "& CO." disclaimed, previously registered for "articles of apparel, namely shirts,"⁴ that, if used on applicant's identified goods, it would be likely to cause confusion or mistake or to deceive. The Examining Attorney has also made final requirement for a disclaimer of the word SPORT.

The appeal has been fully briefed. Applicant withdrew its request for an oral hearing.

At the outset, we note that applicant has submitted certain exhibits with its appeal brief which had not previously been made of record, specifically Exhibits Nos. 4 through 11.⁵ The Examining Attorney has objected to these

³ Application Serial No. 75/615,020, filed December 21, 1998, asserting a bona fide intention to use the mark in commerce.

⁴ Registration No. 1,604,746, issued July 3, 1990; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

⁵ Exhibit Nos. 1-3 were copies of two Office actions and one response filed in the present application, and are of record. Applicant is advised that it is not necessary to file copies of

exhibits as being untimely filed. The Examining Attorney's objection is well taken. Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal, and that the Board will ordinarily not consider additional evidence filed with the Board after the appeal is filed.

We turn first to the requirement for a disclaimer. In response to the Examining Attorney's requirement for a disclaimer of the word SPORT, applicant offered a disclaimer of the separate words WILLS and SPORT. The Examining Attorney pointed out that a disclaimer of WILLS was not necessary, and in his brief advised applicant that if it were offering the disclaimer in order to attempt to overcome the likelihood of confusion refusal, the entry of such a disclaimer would not render registrable a mark which is otherwise unregistrable. In its reply brief applicant reiterated its desire to disclaim both the word WILLS and the word SPORT.

Although an Examining Attorney may require a disclaimer only of an unregistrable component of a mark otherwise registrable, the Commissioner for Trademarks has stated that an applicant may voluntary disclaim a component

these papers with its brief, since they are present in the application file in which the brief is also found.

of a mark, even if that component is registrable matter. See **In re MCI Communications Corp.**, 21 USPQ2d 1534 (Comr. Pats. 1991). Accordingly, the proffered disclaimer of WILLS and SPORT will be entered into the record. Further, because this disclaimer meets the Examining Attorney's requirement for a disclaimer of the word SPORT, the refusal to register based on that requirement is reversed as moot.

We emphasize, however, that the disclaimer of WILLS cannot serve to avoid a finding of likelihood of confusion. As applicant itself has recognized, disclaimers have no effect upon purchasers. Disclaimed material still forms a part of the mark.

This brings us to the refusal based on the asserted likelihood of confusion with the registered mark WILLS & CO. for shirts. In determining this issue, we must consider all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The cited mark is for shirts, while applicant's identified goods include a number of different types of shirts, such as polo shirts, golf shirts, knit shirts, sports shirts and t-shirts. These goods of applicant's are clearly encompassed within the registrant's identified shirts, and therefore applicant's shirts must be deemed to be legally identical to registrant's.⁶ As such, they must be deemed to be sold through the same channels of trade and to the same classes of customers which, in the case of clothing items, would be the public at large.

We turn next to a consideration of the marks, keeping in mind that when marks would appear on or in connection with virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

As applicant has pointed out, citing **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985), marks must be considered in their entirety. However, applicant neglected to quote the additional language in

⁶ Many other goods of applicant's, including culottes, pants, shorts and tank tops, would be considered closely related articles of apparel. However, we need not belabor this point in view of the identical nature of the shirts.

this opinion, namely, that "in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. Id., 224 USPQ at 751.

In this case, we disagree with applicant's contention that its mark, WILLS SPORT and design, is a unitary term. It is clear that the word SPORT is a descriptive term for much of the clothing listed in applicant's identification, including the golf shirts, polo shirts and T-shirts. The Examining Attorney has made of record numerous third-party registrations for apparel in which this word has been disclaimed, thereby showing that it is regarded as descriptive. The Examining Attorney has also submitted with his brief dictionary definitions showing that "sport" is used to describe items "designed or appropriate for outdoor or informal wear: a sport shirt," and that "sportswear" describes a category of "clothes designed for comfort and casual wear."⁷ Because SPORT has such a strong descriptive connotation, consumers will look to other elements of the mark for its source-identifying

⁷ The American Heritage Dictionary of the English Language, 3d ed. © 1992. The Board may take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

significance. Similarly, although applicant's mark has a noticeable design element, it is well established that when a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request or refer to the goods or services.

In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987).⁸

In the present case we see no reason to depart from the general rule, since the design portion of applicant's mark, to the extent it would be articulated at all, is, as applicant describes it, "a large and thick letter 'W'," brief, p. 3, which merely reinforces the WILLS portion of the mark.

Similarly, WILLS must also be considered the dominant portion of the registered mark, since the additional element "& CO." is merely an entity designation which consumers will not look to as a source-identifier.

Thus, when the marks are compared in their entireties, they are very similar in pronunciation, with the word WILLS being identical and the other differences in sound being in the non-distinctive words "SPORT" and "& CO." As stated

⁸ Applicant stated, at p. 4 of its brief, that "the Examiner's position that 'when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services' is untenable and unfounded in both fact and law." Given the statement in **In re Appetito**, we would describe applicant's position as untenable.

above, consumers are not likely to distinguish the marks because of these differences in pronunciation because these additional words do not have any source-identifying value. For similar reasons, the marks are also similar in appearance. The word WILLS is a strong visual element of both marks. Further, because the cited mark is registered in a typed drawing format, its protection is not limited to any particular stylization, and would certainly extend to the minor stylization of the words shown in applicant's mark. The marks are also similar in connotation.

Applicant argues at great length that the cited mark would be regarded as a surname, as indicating the company of a person with the last name WILLS. Assuming that is the case, a similar connotation is conveyed by applicant's mark, namely that of a company named WILLS selling a line of sport clothing.⁹ When the marks are compared as a whole, consumers are likely to believe that the WILLS SPORT and design mark is a variant of, or identifies a sport clothing line of, WILLS & CO. apparel.

Applicant has argued at great length in its brief that the cited mark is primarily merely a surname. We will

⁹ Applicant states, at p. 12 of its brief, that its mark "does in fact conjure up an idea synonymous to Nike's popular slogan 'just do it.'" Suffice it to say that we do not believe that consumers will understand WILLS SPORT to mean the will to win, or anything of the sort.

assume that applicant is not attempting to collaterally attack that registration which, of course, is not allowed. To the extent that applicant is asserting that the cited registration is entitled to a limited scope of protection, we find that its protection would nevertheless extend to applicant's use of such a similar mark for identical goods.

See **Hollister Incorporated v. Ident A Pet, Inc.**, 193

USPQ439 (TTAB 1976). We also think it appropriate to point out that the cited registration issued on the Principal Register without resort to Section 2(f) because, presumably, the Examining Attorney considered it to be inherently distinctive. Certainly the registration should not be given less protection than would a Section 2(f) registration. In any case, surname marks are generally found to have acquired distinctiveness after five years' use; the cited registration is now more than 10 years old, has been renewed, and even in a cancellation proceeding could not be attacked on the basis that it is primarily merely a surname.

Applicant has apparently recognized that it has appropriated the primary feature of the cited mark in its own mark, citing to cases in which no likelihood of confusion was found where registered marks were incorporated into the mark of another. The examples

provided by applicant, FRESH and FEMFRESH, and PET and PETITE, are far different from the present situation, in which the word WILLS retains its significance, and is not a descriptive or highly suggestive term.

Finally, applicant has referred to its other applications for the same mark, in Classes 18 and 28, which were approved for publication. Although evidence as to these applications was untimely filed with the appeal brief, the Examining Attorney did discuss these applications in his brief, and we have therefore considered the existence of the applications and their acceptance for publication. However, the fact that other applications for the same mark but for different goods were approved for publication has no persuasive value herein. We are called upon to consider whether applicant's mark, if used for the goods identified in the subject application, is likely to cause confusion. As noted several times, the cited registration is for goods which are in part identical to the goods identified in the present application, and whether applicant's use of its mark for different goods in other classes is not likely to cause confusion has virtually no persuasive influence in this case.

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Decision: The refusal of registration pursuant to Section 2(d) is affirmed; the requirement for a disclaimer is reversed as moot.